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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,851	12/02/2003	Neal Brady	4672/369	5641
49664 7590 02/18/2009 BRINKS HOFER GILSON & LIONE / CME P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER				
HAMILTON, LALITA M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,851

Applicant(s)

BRADY ET AL.

Examiner

Lalita M. Hamilton

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 5, 19, 20 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 5, 19-20, and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 5, 19-20, and 27-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2, 5, 19-20, and 27-30 recite a process. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 5, and 27, and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Mulinder (7,340,430).

Mulinder discloses a method for real-time trading comprising the subset comprises at least one combination of at least two of the plurality of products, wherein the let least one combination product comprises a product having a plurality of legs, the method further comprising generating at least one indicative quote for the at least one combination in response to alt least one theoretical price for the plurality of legs (col.6, line 38 to col.8, line 9 and col.8, line 50 to col.9, line 30); quote data includes at least one spread parameter provided by the at least one market maker (col.6, line 38 to col.8, line 9 and col.8, line 50 to col.9, line 30); minimizing communications bandwidth among parties trading derivatives, receiving via a network, market data, the market data representative of a state of a market for a plurality of products, receiving via the network, quote data from at least one market maker, the quote data operative to facilitate derivation of at least one quote for at least a subset of the plurality of products, generating a plurality of indicative quotes for the subset of the plurality of products based on the market data and the quote data, and transmitting the plurality of indicative quotes to a subscriber via the network, and facilitating the subscriber to generate a request for actionable quote for at least one product off/lie subset of the plurality of products based on the plurality of indicative quotes and transmit the request for actionable quote to all of the at least one market maker via the network, each of the at

least one market maker being responsive thereto to generate another quote in response to the request for actionable quote and transmit the other quote back to the subscriber via the network wherein the subscriber may generate an order based on the other quote (col.6, line 38 to col.8, line 9 and col.8, line 50 to col.9, line 30); receiving other quote data from another of the at least one market maker, the other quote data being operative to facilitate derivation of at least one quote for at least a subset of the plurality of products and generating another plurality of indicative quotes for the subset of the plurality of products based on the market data and the other quote data, and transmitting the other plurality of indicative quotes to a subscriber via the network, and wherein the quote data may be different than the other quote data (col.6, line 38 to col.8, line 9 and col.8, line 50 to col.9, line 30); and receiving updated quote data from the at least one market maker, the plurality of indicative quotes being generated based the market data and the updated quote data (col.6, line 38 to col.8, line 9 and col.8, line 50 to col.9, line 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19-20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullinder in view of Silverman (6,625,583).

Mullinder discloses the invention substantially as claimed; however, Mullinder does not disclose wherein the quote data comprises at least bid and ask non-binding prices for the plurality of products, comprises analyzing the quote data to eliminate crossed quotes by sorting the bid non-binding prices into descending order and the ask-non-binding orders into ascending order, determining if a cross condition exists in the quote data set, and disregarding crossed quotes based on said determining, and wherein the generating further comprises generating the plurality of indicative quotes that are non-crossed; searching an ordered list of bid prices and ask prices for a first instance of non-crossed quotes; or the quote data comprises a table having quotes for at least each of the subset of the plurality of products and from which the plurality of indicative quotes may be extracted.

Silverman discloses a trading system interface comprising wherein the quote data comprises at least bid and ask non-binding prices for the plurality of products, comprises analyzing the quote data to eliminate crossed quotes by sorting the bid non-binding prices into descending order and the ask-non-binding orders into ascending order, determining if a cross condition exists in the quote data set, and disregarding crossed quotes based on said determining, and

wherein the generating further comprises generating the plurality of indicative quotes that are non-crossed (col.3, lines 15-40; col.4, line 45 to col.5, line 5; and col.7, line 65 to col.8, line 23—the system may be programmed according the specification of the users); searching an ordered list of bid prices and ask prices for a first instance of non-crossed quotes (col.3, lines 15-40; col.4, line 45 to col.5, line 5; and col.7, line 65 to col.8, line 23—the system may be programmed according the specification of the users); and the quote data comprises a table having quotes for at least each of the subset of the plurality of products and from which the plurality of indicative quotes may be extracted (col.3, lines 15-40; col.4, line 45 to col.5, line 5; and col.7, line 65 to col.8, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Silverman within Mullinder for the motivation of allowing the user to program execute any trade desired.

Response to Arguments

Applicant's arguments filed November 21, 2008 have been fully considered but they are not persuasive. The Applicant argues that neither reference discloses or teaches "generating a plurality of indicative quotes for the subset of the plurality of products based on the market data and the quote data, and transmitting the plurality of indicative quotes to a subscriber via the network; and facilitating the subscriber to generate a request for actionable quote for at least one product of the subset of the plurality of products based on the plurality of indicative quotes and transmit the request for actionable quote to all of the at least one market maker via the network, each of the

at least one market maker being responsive thereto to generate an actionable quote in response to the request for actionable quote and transmit the actionable quote back to the subscriber via the network wherein the subscriber may generate an order based on the actionable quote...". In response, Mullinder discloses that a client forwards a request for quote to the system (col.7, lines 10-15). After reviewing the price request, a trader may decide to reject the price request. The trader may modify the price quote in any number of ways. Limits may also be placed on the prices provided by the quote engine (col.8, line 50 to col.9, line 20). Once a price has been determined, it is transmitted back to the client device for review (col.9, lines 20-45). This quote data is provided by FX service provider (market maker exists in the service provider). Therefore, the Examiner is interpreting Mulinder as reading onto the invention as claimed.

The Applicant argues that neither Mulinder nor Silverman disclose or teach mechanisms for request or generating quotes. In response, Mulinder disclose requesting and generating quotes (see response above). Silverman was incorporated as a teaching of various quote data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lalita M Hamilton/
Primary Examiner, Art Unit 3691